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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,368	07/09/2003	Thierry Verpoort	069208.0112	1219

23640 7590 06/21/2005

BAKER BOTTS, LLP
910 LOUISIANA
HOUSTON, TX 77002-4995

EXAMINER	
MENON, KRISHNAN S	

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/616,368	VERPOORT ET AL.	
	Examiner	Art Unit	
	Krishnan S. Menon	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) *1-23 and 29-35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 March 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-15 and 32-35, drawn to a filtration with deleukocytation membrane, classified in class 210, subclass 645.

II. Claims 16-23, drawn to a bag system, classified in class 422, subclass 48.

III. Claims 24-28, drawn to fluid filter material, classified in class 210, subclass 500.1.

IV. Claims 29-31, drawn to method of treating polyurethane filter, classified in class 252, subclass 182.13.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination claims an external enclosure, which is not recited in the combination claims, and therefore not required for the patentability of the combination. The subcombination has separate utility such as, as a fluid filter other than fluid containing leukocytes and platelets.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because invention I is for deleukocytation filter (an apparatus), whereas invention III is for a plasma-treated polyurethane (a material), they have different functions or different effects.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated as a blood-bag system (apparatus) and a plasma treated polyurethane (material).

Inventions I or III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process can be used for another materially different product like plasma treating other polymers, or plasma treating polyurethane for making blood compatible tubes, catheters, etc., instead of filters.

Inventions IV and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are, one is a blood-bag unit, the other is a process for plasma treating polyurethane.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for each Group is different, restriction for examination purposes as indicated is proper.

During a telephone conversation with Michelle LeCointe on 6/17/05 a provisional election was made without traverse to prosecute the invention of group III, claims 24-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-23 and 29-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

The information disclosure statement filed 7/9/03 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in

the English language. It has been placed in the application file, but the information referred to therein has not been considered.

The non-English references, which were not considered, were crossed out from the IDS (PTO-1449).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Katsurada et al (US 5,498,336).

Katsurada teaches a gas plasma-treated polyurethane filter material – see abstract and examples 4-7 as in claim 24; plasma-treated polyurethane is more hydrophilic than the untreated as in claim 27. The material is fibrous or non-woven as in claim 26 – see column 3 lines 5-27.

2. Claims 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuroki et al (US 5,707,520).

Kuroki teaches a plasma treated (column 15 lines 50-65; column 11 lines 34-39) polyurethane material for fluid filter (examples 3, 10-13, etc., table 5), wherein the

plasma treated polyurethane is more hydrophilic than untreated (plasma treatment is done for making polyurethane hydrophilic)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroki et al (US 5,707,520) as applied to claim 24 above in paragraph 2 and further in view of Katsurada et al (US 5,498,336).

Kuroki teaches better than 2-log reduction of leukocytes with no more than 10% removal of platelets from a platelet solution (see table 5) as is recited in claims 27 and 28. Instant claims differ from the teaching of Kuroki in the recitation of 'non-woven fabric' for the porous polyurethane in claim 26. Katsurada teaches that the structure of the filter material can be of various forms such as fibrous, aggregate, non-woven or woven fabric, etc. (see column 3 lines 5-27). Thus Katsurada teaches the various porous structures of the porous body as equivalent. Kuroki teaches the filter structure required as a porous body with certain porosity and pore diameter ranges (see column 5 line 51 – column 6 line 27; column 17 lines 21-35). Kuroki also teaches that non-woven leukocyte removing filters (natural and synthetic) with good efficiency are common in the art in column 1 lines 45-51. Therefore, it would be obvious to one of

ordinary skill in the art at the time of invention that the structure of the porous body as taught by Kuroki can be non-woven as taught by Katsurada, as long as it otherwise meets the requirements of the porous body as required by the teaching of Kuroki. They are considered equivalent unless the applicant can show otherwise with evidence.

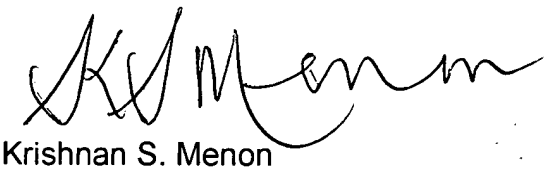
It may also be noted that the limitation "operable to selectively leukodeplete ..." in claims 27 and 28 is functional language, which is not a positive limitation, but only requires the ability to so perform. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S. Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Krishnan S. Menon
Patent Examiner
6/18/05